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REMARKS

Claims 41, 43, 44, 46-48 and 53-76 are pending in the present application.

Reconsideration is respectfully requested for the following reasons.

Applicant would like to thank the Examiner for taking the time for a telephone interview on May 27, 2009. As discussed in the interview, Applicant submits that any combination of the references would not result in the cutting roll 6 of the PCT '540 publication being within a furnace. Accordingly, Applicant submits that the current amendment to claim 41, which was proposed during the telephone interview, would overcome the present rejection as a combination of the references would not include insulation material that enters the tunnel furnace having a rectangular cross-sectional profile and that is impressed and/or deformed to produce a non-rectangular cross-sectional profile during curing.

In the Office Action, claim 41 has been amended. Furthermore, new claims 53-76 depend from claim 41.

In the Office Action, claims 41, 44 and 46-48 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 2,997,096 to Morrison et al. in view of PCT Publication No. WO 00/44540. As further discussed below, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The test for obviousness has recently been addressed by the U.S. Supreme Court in *KSR Int'l. Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007). In its decision, the Supreme Court stated that the teaching-suggestion-motivation (TSM) standard developed by the Federal Circuit was no longer the sole test for determining obviousness. Nevertheless, the Court indicated that the TSM test provides helpful insights as to the obviousness of the invention.

Furthermore, according to M.P.E.P. §2142:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated

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reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Applicants submit that the Office Action has not clearly articulated the reasons why the claimed invention would have been obvious.

Moreover, while the U.S. Supreme Court held that the TSM standard was not the sole standard for finding obviousness, there is at least one element to the finding of a *prima facie* case of obviousness that is common to both the TSM standard and the standards that may otherwise fall within the purview of the *KSR* decision. Specifically, each and every element of the claimed invention must still be considered. As will be set forth below, there are elements of the claimed invention that are missing in their entirety from the cited prior art.

Amended claim 41 defines a method of producing insulation elements made of mineral wool containing curable binder. The method comprises depositing insulation material comprising mineral wool and curable binder on a conveyor, curing and transporting the insulation material through a tunnel furnace, and subjecting sections of the insulation material to controlled compaction in such a manner that at least one permanent impression and/or deformation is produced in the insulation blanket while the insulation material is curing during its passage through the tunnel furnace. The insulation material enters the tunnel furnace having a rectangular cross-sectional profile and the insulation material is impressed and/or deformed to produce a non-rectangular cross-sectional profile during curing.

Applicant submits that the prior art of record does not obviate the above-noted features of claim 41. Specifically, Applicant submits that it is not obvious to combine the Morrison et al. '096 patent with the PCT '540 publication. The Morrison et al. '096 patent relates to the manufacturing of insulation elements comprising mineral wool whereas the PCT '540 publication teaches a method for producing Medium Density Fiberboards ("MDFs"). MDFs do not comprise mineral wool and MDFs are not suitable as insulation elements. MDFs are made of lignocellulose fibers (wood) and not of mineral wool. Hence, MDFs are treated totally different compared to insulation elements containing mineral wool. MDFs cannot be

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treated using a furnace, which is used in the treatment of insulation elements. In fact, MDFs are treated using steam which in turn is not usable for the treatment of mineral wool.

Furthermore, it has to be regarded that MDFs can be shaped using a series of technologies like milling or sawing, which are not applicable to shaping of mineral wool. One skilled in the art would never consider the state of the art relating to MDFs when designing manufacturing techniques for insulation elements with mineral wool. Due to these reasons, it is not obvious to combine the references as set forth in the Office Action.

Moreover, even a combination of the Morrison et al. '096 patent and the PCT '540 publication does not lead to the subject matter of amended claim 41, since the PCT '540 publication discloses the use a steam-injection press 2. However, a steam-injection press is not a tunnel furnace. Therefore, a combination of the Morrison et al. '096 patent and the PCT '540 publication does not include all of the features of claim 41. Moreover, since mineral wool is by far not as stiff as plates made of MDF, the forming techniques used with MDFs are usually not applicable to mineral wool.

Furthermore, as discussed during the telephone interview, a combination of the Morrison et al. '096 patent with the PCT '540 publication does not include the subject matter of amended claim 41. Even though the PCT '540 publication states on lines 12-14 of page 3 that rolls 6 and 7 may not have the same profile, Applicant submits that a combination of the Morrison et al. '096 patent and the PCT '540 publication would not result in insulation material that enters a tunnel furnace having a rectangular cross-sectional profile and that is then impressed and/or deformed to produce a non-rectangular cross-sectional profile during curing.

In view of the above, the Applicant respectfully submits that the Morrison et al. '096 patent and the PCT '540 publication do not disclose the combination of elements of the Applicant's invention as claimed. Accordingly, claim 41 is in condition for allowance.

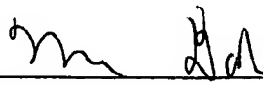
Claims 43, 44, 46-48 and 53-76 depend from claim 41 and since claim 41 defines patentable subject matter as discussed above, claims 43, 44, 46-48 and 53-76 define patentable subject matter. Accordingly, claims 43, 44, 46-48 and 53-76 are in condition for allowance.

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All pending claims 41, 43, 44, 46-48 and 53-76 are believed to be in condition for allowance and a Notice of Allowability is therefore earnestly solicited.

Respectfully submitted,

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Date



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